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09/658,509	09/08/2000	Lorenzo H. Thomson	57012	3375

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ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A.  
1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE  
P.O. BOX 3791  
ORLANDO, FL 32802-3791

EXAMINER

KIM, CHONG HWA

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,509

Applicant(s)

THOMSON ET AL.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 28-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

The Examiner acknowledges the applicant's Amendment filed Jun 10, 2002 in response to the Office action made on May 2, 2202.

#### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 15, 24, 27, 31, 33, 35, 38, 40, 43, and 45 of copending Application No. 09/658,389 in view of Roddy, U.S. Patent 5,881,606 and in view of Giard, U.S. Patent 6,058,800.

The copending Application No. 09/658,389 recites the limitations of the bicycle stem comprising the body portion, the handlebar clamping portion, the handlebar clamping member, the steering tube clamping portion, and the steering tube clamp, wherein the body portion, the handlebar clamping portion, and the steering tube clamping portion are integrally formed as a monolithic unit, but fails to show the fasteners for securing the handlebar clamping member

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having a recess and generally a rectangular shape to the handlebar clamping portion having a recess and generally a rectangular shape; and the body portion being a tubular shape with a hollow interior.

Roddy shows, in Figs. 1-3, a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising a handlebar clamping portion 13 having a recess or cavity 22 and having generally a rectangular shape; a handlebar clamping member 23 having a recess or cavity 22 and having generally a rectangular shape; fasteners 32 securing corners of the handlebar clamping member and the handlebar clamping portion; wherein the handlebar clamping member is removable from the handlebar clamping portion and the cavity 22 is formed to accommodate the handlebar 11.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the rectangular shaped clamping device having fasteners in the corners as taught by Roddy in the handlebar clamping device of the copending Application No. 09/658,389 in order to provide a more securing and stronger clamping device so that the safety of the operator is ensured.

As to the matter of the tubular shape, Giard shows, in Fig. 9, a bicycle stem comprising a body portion 28 and a handlebar clamping portion 43 wherein the body portion 28 has a tubular shape with a hollow interior and wherein the cavity 47 of the handlebar clamping portion 43 has an opening therein in communication with the hollow interior of the body portion 28.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the solid body portion of Roddy with the hollow body portion of Giard in order to provide a lighter device so that less energy is required to propel the bicycle.

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This is a provisional obviousness-type double patenting rejection.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 9, 20-22, and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Giard, U.S. Patent 6,058,800.

Giard shows, in Figs. 1-11, a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising;

a body portion 27 having opposing first 32 and second 31 ends;

a handlebar clamping portion 43 connected to the first end of the body portion 27;

a handlebar clamping member 44 cooperating with the handlebar clamping portion 43 to clamp the bicycle handlebar 23 therebetween;

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the handlebar clamping member 44 and the handlebar clamping portion 43 each having a cavity 47 in a respective medial portion thereof to accommodate an enlarged diameter portion of the handlebar 23;

at least one fastener 49 for securing the handlebar clamping member 44 to the handlebar clamping portion 43;

a steering tube clamping portion 33 connected to the second end of the body portion 27;

the handlebar clamping member 44 has a generally rectangular shape (see Fig. 6) with a recess 47 therein defining with the cavity a pair of spaced apart contact areas 45, 46 for contacting the handlebar 23;

wherein the handlebar clamping member 44 is removable from the handlebar clamping portion 43;

wherein the handlebar clamping portion 43 has a recess 47 therein defining with the cavity a pair of spaced apart contact areas 45, 46 for contacting the handlebar 23;

wherein the body portion 27 has a tubular shape 28 with a hollow interior; and wherein the cavity 47 of the handlebar clamping portion 43 has an opening (see Fig. 9) therein in communication with the hollow interior of the body portion 27;

wherein the steering tube clamping portion 33 has a tubular shape defining a steering tube receiving passageway 34 therethrough, and wherein the steering tube clamping portion 33 also has a clamp receiving passageway 41 therein transverse to the steering tube receiving passageway 34 and in communication therewith (see Fig. 4);

wherein the handlebar clamping member 44 and the handlebar clamping portion 43 both have generally rectangular shapes overlying one another (see Figs. 2, 4, 6, 7); and

wherein the body portion 27, the handlebar clamping portion 43, and steering tube clamping portion 33 are integrally formed as a monolithic unit.

5. Claims 1-4, 6-8, 11-14, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Roddy, U.S. Patent 5,881,606.

Roddy shows, in Figs. 1-3, a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising;

- a body portion 10 having opposing first 13 and second 14 ends;

- a handlebar clamping portion 13 connected to the first end of the body portion 10;

- a handlebar clamping member 23 cooperating with the handlebar clamping portion 13 to clamp the bicycle handlebar 11 therebetween;

- the handlebar clamping member 23 and the handlebar clamping portion 13 each having a cavity 22 in a respective medial portion thereof to accommodate an enlarged diameter portion of the handlebar 11;

- at least one fastener 32 for securing the handlebar clamping member 23 to the handlebar clamping portion 13;

- a steering tube clamping portion 14 connected to the second end of the body portion 10;

- the handlebar clamping member 23 has a generally rectangular shape with a recess 22 therein defining with the cavity a pair of spaced apart contact areas 24, 31 for contacting the handlebar 11;

- wherein the handlebar clamping member 23 is removable from the handlebar clamping portion 13;

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wherein the handlebar clamping portion 13 has a recess 22 therein defining with the cavity a pair of spaced apart contact areas 24, 31 for contacting the handlebar 11;

wherein the handlebar clamping member 23 and the handlebar clamping portion 13 both have generally rectangular shapes overlying one another;

wherein the at least one fastener 32 comprises respective fasteners (see Fig. 1) securing corners of the handlebar clamping member 23 and the handlebar clamping portion 13 together;

wherein the body portion 10, handlebar clamping portion 13 and the steering tube clamping portion 14 are integrally formed as a monolithic unit; and

wherein the steering tube clamping portion 17, 18 has a tubular shape defining a steering tube receiving passageway therethrough, and wherein the steering tube clamping portion 17, 18 also has clamp receiving passageway (for clamp 21) therein transverse to the steering tube receiving passageway and in communication therewith (see Fig. 4).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giard in view of Lai, U.S. Patent 5,509,328.

Giard shows, as discussed above in the rejections of claims 1 and 9; and 20, 24, and 26; a bicycle stem comprising the steering tube clamping portion defining the steering tube receiving



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passageway, but fails to show the steering tube clamp comprising a pair of clamp members aligned in side-by-side relation.

Lai shows, in Figs. 6 and 8, a bicycle stem comprising a steering tube clamping portion 70 having a tubular shape 71 defining a steering tube receiving passageway therethrough, and wherein the steering tube clamping portion 70 has a clamp receiving passageway 74 therein transverse to the steering tube receiving passageway 71 and in communication therewith; and further comprising a steering tube clamp 81, 82 in the clamp receiving passageway 74 and comprising a pair of cooperating clamp members 81, 82 aligned in side-by-side relation and comprising respective portions defining a recess 87, 88 therein for the steering tube 6.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the clamping device of Giard with the pair clamp device of Lai in order to provide a tighter and more versatile clamping device so that the operation of the bicycle is not compromised.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roddy in view of Giard.

Roddy shows, as discussed above in the rejection of claim 11, the bicycle stem comprising the body portion having the handlebar clamping portion, but fails to show the body portion having a hollow interior which communicate with an opening in the handlebar clamping portion.

Giard shows, in Fig. 9, a bicycle stem comprising a body portion 28 and a handlebar clamping portion 43 wherein the body portion 28 has a tubular shape with a hollow interior and

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wherein the cavity 47 of the handlebar clamping portion 43 has an opening therein in communication with the hollow interior of the body portion 28.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the solid body portion of Roddy with the hollow body portion of Giard in order to provide a lighter device so that less energy is required to propel the bicycle.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roddy in view of Lai.

Roddy shows, as discussed above in the rejections of claims 11, 16, and 18, a bicycle stem comprising the steering tube clamping portion defining the steering tube receiving passageway, but fails to show the steering tube clamp comprising a pair of clamp members aligned in side-by-side relation.

Lai shows, in Figs. 6 and 8, a bicycle stem comprising a steering tube clamping portion 70 having a tubular shape 71 defining a steering tube receiving passageway therethrough, and wherein the steering tube clamping portion 70 has a clamp receiving passageway 74 therein transverse to the steering tube receiving passageway 71 and in communication therewith; and further comprising a steering tube clamp 81, 82 in the clamp receiving passageway 74 and comprising a pair of cooperating clamp members 81, 82 aligned in side-by-side relation and comprising respective portions defining a recess 87, 88 therein for the steering tube 6.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the clamping device of Roddy with the pair clamp device of Lai

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in order to provide a tighter and more versatile clamping device so that the operation of the bicycle is not compromised.

10. Claims 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roddy in view of Giard.

Roddy shows, in Figs. 1-3, a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube, the bicycle stem comprising;

a body portion 10;

a handlebar clamping portion 13 connected to an end of the body portion 10 and having a recess 22 therein for the handlebar 11;

a handlebar clamping member 23 cooperating with the handlebar clamping portion 13 to clamp the bicycle handlebar 11 therebetween, the handlebar clamping member 23 having a recess 22 for the handlebar 11;

at least one fastener 32 for securing the handlebar clamping member 23 to the handlebar clamping portion 13; and

wherein the handlebar clamping member 23 and the handlebar clamping portion 13 both have generally rectangular shapes overlying one another;

but fails to show the body portion having a hollow interior which communicate with an opening in the handlebar clamping portion.

Giard shows, in Fig. 9, a bicycle stem comprising a body portion 28 and a handlebar clamping portion 43 wherein the body portion 28 has a tubular shape with a hollow interior and

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wherein the cavity 47 of the handlebar clamping portion 43 has an opening therein in communication with the hollow interior of the body portion 28.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the solid body portion of Roddy with the hollow body portion of Giard in order to provide a lighter device so that less energy is required to propel the bicycle.

### *Response to Arguments*

11. In response to the Applicant's argument that the Double Patenting Rejection is improper, it is the Examiner's view that the Double Patenting Rejection is proper. A bicycle stem attached to a handlebar clamping portion as disclosed in the present invention is the same bicycle stem attached to a steering tube clamping portion as disclosed in 09/658,389 except that the attaching ends of the bicycle stems are reversed. Claiming that two portions are different because one is for attaching to a steering tube and the other is for attaching to a handlebar is not convincing. First of all, the recitation in the preamble of the claim preceding with the word "for" is for intended use and given no patentable weight. And second, both applications claim a bicycle stem. A bicycle stem is a bicycle stem whether it is intended to be attached to the steering tube or the handlebar.

12. In response to the Applicant's argument that Girard does not show the cavity to accommodate the enlarged diameter portion of the handlebar, it is the Examiner's contention that Girard does show such configuration. Claim 1 simply recites "said handlebar clamping member and said handlebar clamping portion each having a cavity in a respective medial portion thereof to accommodate an enlarged diameter portion of the handlebar" in lines 11-14. Girard shows, in

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Fig. 9 both clamping member 44 and clamping portion 43 having a cavity 47 (the word “cavity” is defined as “an unfilled space within a mass” in Merriam Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition) in a respective medial portion thereof to accommodate the enlarged diameter portion of the handlebar 23. Claim 10 recites that there is a recess in the handlebar clamping member for the handlebar and a cavity in the medial portion of the recess. Girard shows, in Fig. 9 the handlebar clamping member 44 having a recess 47 for the handlebar and a cavity (the portion that looks like an opening on the right side) in a medial portion of the recess.

13. In response to the Applicant’s argument that Roddy does not show the cavity as recited in claims 1 and 11, again it is noted that the word “cavity” is defined as “an unfilled space within a mass” in Merriam Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition. Therefore, clearly, Roddy shows the handlebar clamping member 23 and the handlebar clamping portion 13 each having a cavity 22 in a respective medial portion thereof to accommodate an enlarged diameter portion of the handlebar 11.

14. In response to the Applicant’s argument that Roddy in view of Girard in rejection of claim 20 fails to show the clamping portions accommodating the enlarged portions of the handlebar, it is the Examiner’s position that both Roddy and Girard show the clamping portions accommodating the enlarged portion of the handlebar. The clamping portions have been discussed above in the response to the argument in paragraphs 12 and 13. If the applicant’s argument is related to the enlarged portions of the handlebar, it is noted that the handlebar is recited as intended use and therefore has not given a patentable weight. However, even if the handlebar is positively claimed, both Roddy and Girard shows the enlarged portions of the handlebar. Both handlebars in Roddy and Girard are hollow tube-like bars. Such hollow bars as

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shown by Roddy and Girard can be construed as being "enlarged" since there are some methods involving the enlargement of the tube by pneumatic pressure forming method.

*Conclusion*

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CHK  
July 31, 2002

  
Chong H. Kim  
Primary Examiner  
Art Unit 3682